

Application/Control Number: 09/676,270
Art Unit: 2686

Docket No.: PALM-3197

REMARKS

Reconsideration and allowance are respectfully requested. Claim 9 is amended.

Claims 1, 3 - 9 and 11 - 26 are pending.

Rejection of Claims 9, 11 - 17 Under Section 112

Claim 9 is amended to clarify the invention such that the claim recites using the address to retrieve the name from the memory cache. Accordingly, Applicants respectfully request withdrawal of this rejection. Therefore, inasmuch as no other rejections are made for these claims, Applicants submit that claims 9 and 11 - 17 are patentable and in condition for allowance.

Rejection of Claims 1, 3 - 8 and 18 - 26 Under Section 103

The Examiner rejects claims 1, 3 - 8 and 18 - 26 under section 103 as being unpatentable in view of the Bluetooth Specification, Slaughter et al. and Kephart et al. Applicants traverse this rejection and submit that there is insufficient motivation to combine these references and even if combined, Applicants submit that these references do not teach each claim limitation.

We first turn to claim 1. To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the

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artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

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With these principles in mind, we turn to the references. The Bluetooth Specification cited by the Examiner defines a profile of generic procedures to discover Bluetooth devices and link management aspects of connecting to Bluetooth devices. Part K:1, page 13.

Bluetooth is a wireless protocol known to apply to communications in a short range with wireless devices. Examples include headset usage, cordless telephones (not cellular phones), and LANs. These are set forth in the cited Bluetooth Specification. The protocol enables small, mobile and wireless devices to communicate with another device. These features of Bluetooth are important in terms of what they suggest to one of skill in the art. We shall see that these features prevent, by a preponderance of the evidence, the Bluetooth Specification from being combined with Slaughter et al. and Kephart et al.

Slaughter et al teach, as is shown in FIG. 1, a telephone communication system in which a remote computer 12 communicates through telephone lines 22 with a remote access server 16. Slaughter et al. fail to suggest any wireless application beyond a cellular phone application. In fact, they teach in col. 3, lines 45-50 uses modem that may also use the ISDN network or "any variety of other switched-access devices." As for the remote device, Slaughter et al. explains that it is "a powerful programmable computer." Col. 3, lines 17-19. Therefore, the Slaughter et al. approach is a telephone approach (whether digital, analog or wireless) requiring modems for each computing device connected through a network. The context of the Bluetooth protocol, as is known to those of skill in the art, differs for small handheld wireless devices that do not have a modem and do not communicate via a wired telephone line network or a cellular network. Applicants respectfully submit that where the standard of obviousness is only by a preponderance of the evidence, that it is less likely that there is sufficient suggestion or motivation to combine these references than more likely to find such motivation.

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When Kephart et al. is added into the combination of references, the case for obviousness is even tougher. For example, Kephart et al. relates to a DNS name server application. This is for the standard TCP/IP protocol. Applicants submit that one of skill in the art would understand that enabling clients to match IP addresses and server names by using the DNS name server will differ from the Bluetooth Protocol in which there is not a DNS server. Further, where Slaughter et al. utilizes a telephone line-based system, Applicants would submit that there is insufficient motivation to one of skill in the art to blend a TCP/IP protocol based application from Kephart et al. with the old telephone system of Slaughter et al. Applicants respectfully submit that these three references are different to the extent that one of skill in the art would not find motivation or suggestion to combine them together.

Another reasons there is no suggestion to combine these references is that the Bluetooth Specification already teaches a method of obtaining the name of the remote device and there is no suggestion to abandon the Bluetooth system for another system such as in Kephart et al. For example, the Bluetooth Specification, section 6.3 is about "Name Discovery". This is how in Bluetooth a initiator obtains the names of Bluetooth devices. FIG. 6.3 shows how the paging and name request occurs. FIG. 6.4 shows a listing of Bluetooth Device Names and name requests for each of devices B, B' and B''. In sum, there is a name discover procedure for Bluetooth that is established. There is not sufficient motivation or suggestion for one of skill in the art to abandon the established name discovery procedure already in Bluetooth for the DNS server approach of the TCP/IP protocol. Certainly, under a preponderance of the evidence standard, one of skill in the art would not be *motivated* to take such an approach.

For these reasons, Applicants submit that claims 1, 3 - 8 and 18 -26 are patentable and in condition for allowance.

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Furthermore, even if these references are combined, they still fail to teach each claim limitation. For example, claim 1 requires transmitting a wireless request for a name to the responding device if the name is not in the memory cache and receiving the name for the responding device in response to the wireless request. Notably, the request for the name is transmitted to the responding device, not to another device. It is clear that Kephart et al., FIG. 3, that the DNS name server 32 receives the request from the client 10 to match up the IP address for the server 34. Simply put, the client in Kephart et al., if it does not have stored the name and IP address of server 34, transmits a request to a different computing device (the DNS server 32). In this regard, this differs from the present invention in which only two devices (the initiator device and the responding device) communicate. Therefore, even if combined, these three references fail to teach the limitations of claim 1.

Therefore, claim 1 and dependent claims 3 - 8 are patentable.

Similarly, claim 18 and dependent claims 19 - 26 are patentable as well for the same reasons set forth above.

CONCLUSION

Having addressed all rejections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

The Commissioner is hereby authorized to charge any necessary fees (or credit any overpayments) associated with this communication and which may be required to Deposit Account No. 50-3102, referencing Attorney Docket No. PALM-3197.

Respectfully submitted,

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